

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-32 are pending in the application. Claims 1, 7, 15, 21, and 27 have been amended. The amendment is supported by the original disclosure. No new matter has been introduced.

Claim Rejections – 35 U.S.C. §102:

Claims 1, 3-6 and 15-32 were rejected under 35 U.S.C. §102(b) as being anticipated by Fujioka et al., (U.S. Patent No. 5,414,481) (hereinafter "Fujioka").

Assignee respectfully submits that Fujioka does not disclose all of the elements of the independent claims. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

For example, Examiner has not established that Fujioka discloses "*focusing an image of a first object through a transparent window of an optical scanner, wherein the first object is positioned remote from said transparent window; and scanning the image focused through the transparent window to obtain an image of the first object.*"

First, in the Office Action dated March 6, 2006, the Examiner has made assertions that the claimed feature is "common" in the art, stating:

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It is common for an overhead projector such as Fujioka to be used to project (or in the reverse image) either a blackboard or white board. (See page 3 of the Office Action.)

Assignee continues to traverse the Examiner's assertion of such "common" knowledge. It is simply legally insufficient to establish anticipation under 35 U.S.C. § 102 based solely on what is "common". The Examiner needs to provide substantial evidence on the record that establishes such common knowledge. In fact, the Examiner is kindly reminded that:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence on which a rejection was based. . . . As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. MPEP 2144.03 (Emphasis added)

However, the Examiner has not cited to any evidence whatsoever that would substantially support the Examiner's above quoted assertion of what is "common". Specifically, the Examiner has provided no support from Fujioka anticipating "*scanning the image focused through the transparent window to obtain an image of the first object*" where "*the first object is positioned remote from said transparent window*", as claimed. Thus, without any such evidence supporting what the Examiner says is "common", this statement cannot be maintained, so the rejection on this basis must be withdrawn.

Second, the Examiner contends that Fujioka teaches that:

[T]he optics of the projector are capable of passing an image of a projection screen down to the scanner (5) (See for example JP 06-148744 to Sakai which in figure 3 shows passing an image off of a screen through optics down to a sensor (14). (See page 3 of the Office Action.)

However, instead of citing to where this feature is shown in *Fujioka*, the Examiner contends that *Sakai* shows the inherency of the feature, stating:

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Sakai reference has been added to show that it is inherent that the projection optics of an overhead projector can in fact image the projection surface. (See page 12 of the Office Action.)

Lastly, the Examiner contends that Sakai shows the inherency of the claimed feature, stating:

The ability for common projector optics to do so is demonstrated by the Sakai reference (JP6-148744) which clearly shows in figure 11 a light beam from a projection surface being imaged through projector optics 7, through a transparency 3 and down to a scanner of some sort (14). (See the Advisory Action of June 8, 2006.)

However, Assignee traverses the Examiner's inherency argument because the Examiner has failed to establish a sufficient nexus between Sakai and Fujioka to support a conclusion that what is shown in Sakai is inherently disclosed in Fujioka. The Examiner is kindly reminded that the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' MPEP § 2112. (Emphasis added)

Assignee submits that the Examiner is incorrect in describing item 14 of Sakai as a "a scanner of some sort (14)", and that the Examiner has pointed to no portion of Sakai relevant to the claimed limitation of "*focusing an image of a first object through a transparent window of an optical scanner, wherein the first object is positioned remote from said transparent window.*"

Specifically, the Examiner has not pointed to any portion of Sakai supporting the assertion that

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"an image", as is claimed, is passed to item 14 of Sakai. Conversely, the Abstract of Sakai specifically describes item 14 as "an optical sensor 14" for detecting "light emitting type indicator 18" and not as a scanner. See the Abstract of Sakai. Additionally, the Abstract of Sakai indicates that Sakai is directed to "remote control operation", presumably such as done by "optical sensor 14" detecting "light emitting type indicator 18" to execute "drive controls". See the Abstract of Sakai. Accordingly, Assignee invites the Examiner to provide any extrinsic evidence supporting the Examiner's contention of inherency or an affidavit establishing facts known by the Examiner supporting the Examiner's contention of inherency. In the absence of such evidentiary showing by the Examiner, Assignee respectfully requests that the Examiner withdraw the anticipation rejection.

Likewise, claims 1, 3-6, and 15-32 distinguish from Fujioka on at least the same or similar basis. Therefore, Assignee respectfully requests that Examiner's anticipation rejection of claims 1, 3-6, and 15-32 be withdrawn.

Claim Rejections – 35 U.S.C. §103:

Claims 2 and 7-14 were rejected under 35 USC § 103 as being unpatentable over Fujioka in view of various additional art. Specifically, claim 2 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. as applied to claims 1, 3-6 and 15-32 above, and further in view of Minnesota Mining and Manufacturing Company (3M), (EP 0 550 038); claims 7-8 and 11-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. in view of Konno et al. (US Patent 5,325,137); claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al. in view of Konno et al. as applied to claims 7-8 and 11-14 above, and further in view of Stocker (US Patent 2004/0095614); and claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka in view of Konno as applied to

claims 7-8 and 11-14 above, and further in view of Minnesota Mining and Manufacturing Company (3M), (EP 0 550 038).

In response, Assignee respectfully submits that claims 2 and 7-14 are not obvious, at least on the same or similar basis as claim 1 as set forth above with respect to the anticipation rejection in view of Fujioka. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (See MPEP § 2143.03.)

Specifically, the Examiner has failed to establish that Fujioka teaches or suggests "*a lens, disposed on the arm and located at a reflecting path of the reflective mirror, and wherein the lens is capable of horizontally focusing an image of a generally vertical object through the transparent window, the generally vertical object being disposed at a location remote from the transparent window; and a scanning module, disposed within the scanning body and capable of reciprocally moving underneath the transparent window, and wherein the scanning module is capable of obtaining an image of the generally vertical object focused by said focusing device*", as recited in independent claim 1. Additionally, Assignee respectfully submits that the Examiner has failed to establish that the proposed combinations cure Fujioka of this failure. In the absence of the Examiner pointing to such a disclosure in the proposed combinations, Assignee respectfully requests that the rejection be withdrawn on the basis that the Examiner has failed to establish that the proposed combinations teach or suggest all the claim limitations.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by

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the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Additional fees

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Respectfully submitted,

Attorney for Assignee

Dated: September 6, 2006

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